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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,133	03/27/2001	Randall A. Russell	RUS001-461611.1	3821

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EXAMINER
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HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/819,133

Applicant(s)

RUSSELL, RANDALL A.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, **as amended by any amendment specifically referred to in the oath or declaration.**

### *Specification*

The abstract of the disclosure is objected to because it exceeds the 150-word limit. Correction is required. See MPEP § 608.01(b) and CFR 1.72(b).

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites the phrase "may optionally". It is unclear to the Examiner if the limitation appearing after this phrase is required in the Applicant's invention. For examination purposes, the Examiner will assume that the phrase "may optionally" indicates that the limitation is an option which may or may not be present.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites the limitation "means by which..." in line 1 of the claim. It is unclear to the Examiner if the Applicant is attempting to invoke 112, 6<sup>th</sup> paragraph by the use of this limitation. MPEP 2181 clearly sets forth the guidelines for a proper invocation of 112, 6<sup>th</sup> paragraph. In particular, the MPEP guidelines call for a "means for..." phrase that is modified by functional language. In the present case, the Applicants have not used the phrase "means for..." Appropriate action is required.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what the structural relationship is between the limitations of claim 14 and claim 1. An art rejection of this claim has been withheld pending clarification of the 112 rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claim 1, 2, 4, 5, 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charles Davis "Simple Solution" (hereinafter referred to as Davis).**

Referring to claim 1, Davis teaches a system comprising: an electronic network computer which is accessible by students, parents, and vendors via an electronic network (page 1, paragraph 2), said computer including software having a commerce database module by which a parent previously established a student account with pertinent information about the student and with information as to how the account is to be funded from a third party financial institution by said parent (page 1, paragraph 2) and with information as to spending restrictions with a vendor which are imposed on said account by said parent (page 1, paragraph 3). Davis does not teach that the computer is a "central controller trustee" computer. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the system would be the same regardless of what adjectives were used to describe the network computer system. The difference between the Applicant's network computer and the prior art's on-line computer is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to assign any name to the on-line computer system of the cited prior art because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention. Davis also does

not teach that school trustees are able to access the network computer. However, this limitation is deemed to be nonfunctional descriptive material also since it is not functionally involved in the elements of the recited system. The elements of the system would be the same regardless of who was able to access the network computer. The difference between the Applicant's invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow any group of people to access the on-line computer system of the cited prior art because such access does not functionally relate to the elements of the claimed system and because such access is purely subjective and does not patentably distinguish the claimed invention. Davis also teaches debit means for transferring funds from said third party financial institution into said student account and debit means for transferring funds from student account to vendor account (page 1, paragraph 2). Davis does not explicitly teach that the funds are transferred when a student inputs a unique identifier and password. However, the use of the unique identifier is inherent in the system of Davis because Davis teaches "...PocketCard...works like any other credit card online." (page 1, paragraph 2). Therefore PocketCard would inherently have a unique account number for the student to enter during the transaction otherwise the tracking features described in paragraphs 3 and 5 would not work. Finally, Davis does not teach a password. However, it would

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have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a password feature into the system of Davis. One of ordinary skill in the art would have been motivated to do so in order to prevent an unauthorized user from using someone else's PocketCard account.

Referring to claim 2, Davis does not teach that the student account is a common account for a plurality of students of a parent. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into PocketCard. One of ordinary skill in the art would have been motivated to do so in order to limit the number of cards a parent had to purchase.

Referring to claim 4, Davis teaches means for monitoring account to determine if a minimum balance is present in said account (page 1, paragraph 4). Davis does not teach means for notifying parent if said minimum balance is not present in said account. However, Davis teaches e-mail alerts whenever the PocketCard is used (page 2, paragraph 3). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate means for notifying if the minimum balance is not present in the account. One of ordinary skill in the art would have been motivated to do so in order to provide greater control over the spending activity, as taught by Davis.

Referring to claim 5, Davis teaches means for determining a balance transaction history in account and means for electronic access to said balance and said transaction history in said account (page 1, paragraphs 2 and 3; page 2, paragraph 2).

Referring to claims 7 and 8, Davis teaches means for transferring funds, means for determining account balance and transaction history in account, and means for accessing an account (pages 1 and 2). Davis does not teach that the account is a vendor account. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the system would be the same regardless of who owned the account. The difference between the Applicant's invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the structure of the cited prior to transfer funds to anyone's account because the ownership of an account does not structurally relate to the elements of the claimed system and because the subjective interpretation of ownership does not patentably distinguish the claimed invention.

Referring to claim 9-12, Davis teaches means for notifying, means for selecting, and means for accessing (pages 1 and 2). Davis does not teach that these structural elements are tied to information about school events, student information, or school information. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The elements of the system would be the



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same regardless of what information was stored in the system. The difference between the Applicant's invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the structure of the cited prior for any information because the subjective interpretation of such information does not patentably distinguish the claimed invention.

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charles Davis "Simple Solution" in view of Vicki Young "Online sites find new ways to encourage teen shoppers" (hereinafter referred to as Young).**

Davis does not teach means for verifying that there are no restrictions on said student account that would prohibit a transaction with a vendor. However, Young teaches a system for online shopping wherein a parent can control which sites a teenager can access (page 2, paragraph??). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Young into the system of Davis. One of ordinary skill in the art would have been motivated to do so in order to allow a parent to prevent their child from accessing and doing business with a salacious merchant.

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**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charles Davis "Simple Solution" in view of Gardner et al. (US Patent 2002/0178034 A1).**

Davis does not teach means for monitoring said account for abnormal account activity, or means for notifying someone of said abnormal account activity. However, Gardner teaches these limitations (columns 11 and 12, paragraph [0160]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gardner into the system of Davis. One of ordinary skill in the art would have been motivated to do so in order to monitor for irregular practices, as taught by Gardner.

**Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charles Davis "Simple Solution" in view of Official Notice.**

Davis does not teach means for inputting information into a database. However, Official Notice is taken that it is old and well known in the art to use a keyboard or mouse to input data into a database. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a keyboard or mouse into the invention of Davis. One of ordinary skill in the art would have been motivated to do so in order to allow a user to use a well-known input device to input data into the database of Davis.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

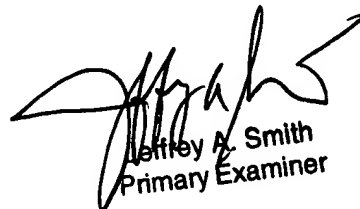
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

April 18, 2004



Jeffrey A. Smith  
Primary Examiner